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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,762	09/17/2003	Yoshiyuki Akiyama	450101-03749.3	6976
7590	11/30/2004		EXAMINER	
William S. Frommer, Esq. Frommer Lawrence & Haug LLP 745 Fifth Avenue, 10th Fl. New York, NY 10151			AGUSTIN, PETER VINCENT	
			ART UNIT	PAPER NUMBER
			2652	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/665,762	AKIYAMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Peter Vincent Agustin	2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 28-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 28-32 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 September 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. 08/825,890.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/17/03.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

**DETAILED ACTION**

*Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/825,890, filed on April 2, 1997.

*Specification*

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

*Claim Objections*

4. Claims 29 & 30 are objected to because of the following informalities:

Claim 29, line 2: "being associated" should be --is associated--.

Claim 29, line 2: "being recorded" should be --is recorded--.

Claim 30, line 2: "being previously" should be --is previously--.

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites the limitation “the wobbled signal” on line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 29 recites the limitations “the information” on line 2 and “the information 1” on line 3. There is insufficient antecedent basis for these limitations in the claim. Furthermore, the specification and the claims do not provide a clear description/antecedent basis for the limitation “1/0 of the information”.

Claim 30 recites the limitation “the number of contiguous 0 of the information” on lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 31 recites the limitation “the wobbled signal” on line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 32 recites the limitation “the wobbled signal” on line 7. There is insufficient antecedent basis for this limitation in the claim.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 28 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,075,761.

Claim 28 recites an optical recording medium comprising an “address information” recorded on the land region; while patent claim 1 recites an optical recording medium having “a plurality of first pits” formed in the land region. The “plurality of first pits” of patent claim 1 could have obviously been corresponding to the claimed “address information”.

Claim 28 recites that the address information is recorded “at a position that corresponds only with a maximum amplitude of the wobbled signal”; while patent claim 1 recites that each first pit are formed “in a wobbling period at a substantially equivalent phase position with respect to the wobbled groove”. The “equivalent phase position” of patent claim 1 could have obviously been one of plurality of phases ranging from 0° to 360°, including a minimum peak of one wobble period and a maximum peak of one wobble period, i.e., the claimed “position that corresponds only with a maximum amplitude of the wobbled signal”.

Claim 28 does not recite that “a first pit being present when only a single pit is present in a wobbling period on said one side”, which limitation is recited on patent claim 1. It should be noted, however, that deletion of this element would have been an obvious expedient because the claimed optical recording medium would perform equally well either when “only a single pit is present in a wobbling period” or when multiple pits are present in a wobbling period, and applicant has not disclosed that the presence of multiple pits provides an advantage, is used for a particular purpose, or solves a stated problem. (See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7

(CCPA 1975)). Furthermore, the presence of multiple pits in a wobbling period would have been an obvious matter of design choice.

9. Claims 29 & 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,075,761 in view of Maeda et al. (JP 03083265).

For a description of patent claim 1, see the rejection above. However, patent claim 1 does not explicitly recite that the address information being associated with 1/0 of the information, and being recorded only at a position corresponding to the information 1 (claim 29); and that the address information being previously modulated so that the number of contiguous 0 of the information will be two at the maximum (claim 30).

In regard to claim 29, Maeda et al. (see constitution) inherently disclose associating address information with 1/0 of the information, and being recorded only at a position corresponding to the information 1 (note that when an information is “1”, a mark is necessarily written/recorded, and when an information is “0”, no writing/recording takes place). In regard to claim 30, Maeda et al. disclose that the address information is previously modulated so that the number of contiguous 0 of the information will be two at the maximum (see constitution: “biphase mark modulation”, note that in biphase modulation, the number of contiguous 0 of an information will either be zero, one or two). It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have modulated the address information of the claimed invention of U.S. Patent No. 6,075,761 so that the number of contiguous 0 of the information will be two at the maximum as suggested by Maeda et al., the motivation being to record/reproduce data with a higher density, an advantage of bi-phase modulation that is very

well-known in the art (see for example Kobayashi et al. (US 5,754,522), column 2, lines 21-26 and column 5, lines 35-50).

10. Claim 31 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26, 27 & 29 of U.S. Patent No. 6,075,761.

Claim 31 has limitations that are similar to those of claim 28; thus, it is rejected using the same rationale as applied to claim 28 above.

Furthermore, claim 31 recites a recording and/or reproducing apparatus comprising a detecting circuit, but does not recite the “controller” of patent claim 26. It should be noted, however, that deletion of the controller would have been an obvious expedient where the function attributed to the controller is not desired or required for the claimed apparatus because the optical recording medium is not claimed as a component of the apparatus; therefore, the functions “controls rotation” and “detects a position” of the patent claimed “controller” are not required.

Furthermore, the limitation “for recording and/or reproducing an optical recording medium having a wobbled groove formed in the optical recording medium, the wobbled groove having a sinusoidal shape, the sinusoidal shape defining a plurality of wobbling periods, a land region of the medium between neighboring turns of the wobbled groove, and address information recorded on the land region adjacent to the groove, the address information on one side of a turn of the wobbled groove being recorded at a position that corresponds only with a maximum amplitude of the wobbled signal, the position being proximate to a neighboring groove” recited on lines 1-8 is seen to be an obvious expedient since this limitation merely states an intended use. (See Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315 (Fed. Cir. 1988)).

Claim 31 recites that the detecting circuit has “a photo-detector that detects a push-pull signal”; while patent claim 27 recite that the detecting circuit has “first and second detectors that detect...by subtracting two signals from the first and second detectors”. It should be noted that these two recitations both cover the same thing, despite a slight difference in wording. As shown for example by Musha et al. (US 4,544,838) on lines 7-13 of the abstract, a push-pull signal is a difference between outputs of two light-receiving sections.

Claim 31 recites that the detecting circuit has “a high pass filter”, but does not recite the “combining circuit” and “band pass filter” of patent claim 29. It should be noted, however, that deletion of these elements would have been an obvious expedient. The patent claimed “combining circuit” is not required because claim 31 does not recite that the inherently suggested light receiving sections of the photo-detector are each further sub-divided into plural parts. Thus, the patent claimed “band pass filter that detects the pit signals from the combined signal” is also not required. (See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)).

11. Claims 31 & 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 & 2, respectively, of U.S. Patent No. 6,469,961.

Claims 31 & 32 recite a recording and/or reproducing apparatus for recording and/or reproducing an optical recording medium comprising an “address information” recorded on the land region; while patent claims 1 & 2 recite a recording and/or reproducing apparatus for recording and/or reproducing an optical recording medium having “a plurality of first pits” formed in the land region. It should be noted, however, that the patent recited limitation is seen to be an obvious expedient since this limitation merely states an intended use of the recording

and/or reproducing apparatus. (See Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315 (Fed. Cir. 1988)).

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 703-305-8980. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin  
Art Unit 2652

*[Handwritten signature of Hoa T. Nguyen]*  
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11/24/04